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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,159	01/20/2004	Satish Parolkar	P24473	6660

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GREENBLUM & BERNSTEIN, P.L.C.  
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RESTON, VA 20191

EXAMINER
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HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/759,159

**Applicant(s)**

PAROLKAR ET AL.

**Examiner**

Allan Hoosain

**Art Unit**

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/28/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-24 of US 6,704,396 Patent.

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The subject matter claimed in the instant application is fully disclosed in the referenced US Patent. Since the referenced US Patent and the instant application are claiming common subject matter, as follows:

All the limitations in claims 1-20 of the instant application are recited in corresponding claims 1-24 of the US Patent.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5,11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by **Holden** (US 6,771,639).

As to Claims 1,11,17 with respect to Figures 1-6, **Holden** teaches a method of collecting information, comprising:

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sending an interactive text markup programming language script, using a session initiation protocol (SIP) message, to a communications device, the interactive script including at least a first query and a second query that depends on a response to the first query (Figure 6); and

receiving the response from the communications device, the response being based upon input from a user of the communications device (Figure 6).

As to Claims 2,13, **Holden** teaches the method of collecting information of claim 1, wherein the received response comprises information of at least one of a location of the communications device, a type of the communications device, a communications format used by the communications device, a communications mode desired by the user of the communications device, a personal identification of the user of the communications device, an account number of the user of the communications device, a password of the user of the communications device, billing information of the user of the communications device, the intent of the user of the communications device, a preferred language of the user of the communications device, and a question from the user of the communications device (Col. 7, lines 60-67).

As to Claims 3,14, **Holden** teaches the method of collecting information of claim 1, wherein the received response is a textual representation of one of a DTMF tone, VoicexML and HTML speech tags (Col. 8, lines 63-67).

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As to Claims 4,15, **Holden** teaches the method of collecting information of claim 1, further comprising providing the response to a user of a recipient device (Figure 6).

As to Claims 5,16,18, **Holden** teaches the method of collecting information of claim 1, the response being additionally based upon information provided by the communications device (Col. 7, lines 60-67).

As to Claim 12, **Holden** teaches the method of interactively pre-screening user information of claim 1, further comprising establishing a communications connection between the communications device and one of a plurality of agent devices, the one of the plurality of agent devices being determined based on the response (Col. 8, lines 1-6).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **LaPorta et al.** (US 5,970,122) in view of **Vo et al.** (US 6,795,444).

As to Claims 1,6,11,17,19, with respect to Figures 1-3, **LaPorta** teaches a method of collecting information, comprising:

sending MSG 8 (an interactive text markup programming language script), using a session initiation protocol (SIP) message, to a communications device, the interactive script including a lunch request (at least a first query) and lunch request response (a second query that depends on a response to the first query) (Figure 3); and

receiving the response from the communications device, the response being based upon input from a user of the communications device (Figure 3);

**LaPorta** does not teach the following limitation:

“using a session initiation protocol (SIP) message”

However, it is obvious that **LaPorta** suggests the limitation. This is because **LaPorta** teaches sending messages over the world wide web (Col. 4, lines 25-27). **Vo** teaches sending SIP messages over the world wide web (Figures 1, labels 130,108,138). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add SIP messaging to **LaPorta**’s invention for protocol conversions between networks as taught by **Vo**’s invention in order to provide communications in integrated networks.

As to Claims 2,7,13, **LaPorta** teaches the method of collecting information of claim 1, wherein the received response comprises information of at least one of a location of the communications device, a type of the communications device, a communications format used by the communications device, a communications mode desired by the user of the communications device, a personal identification of the user of the communications device, an account number of the user of the communications device, a password of the user of the communications device, billing information of the user of the communications device, the intent of the user of the communications device, a preferred language of the user of the communications device, and a question from the user of the communications device (Figure 3, labels 58,60,62).

As to Claims 3,8,14, **LaPorta** teaches the method of collecting information of claim 1, wherein the received response is a textual representation of one of a DTMF tone, VoicexML and HTML speech tags (Figure 3, label 62).

As to Claims 4,9,15, **LaPorta** teaches the method of collecting information of claim 1, further comprising providing the response to a user of a recipient device (Figure 3, label 50a).

As to Claims 5,10,16,18,20, **LaPorta** teaches the method of collecting information of claim 1, the response being additionally based upon information provided by the communications device (Figure 3 and Col. 11, lines 45-55).



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As to Claim 12, **LaPorta** teaches the method of interactively pre-screening user information of claim 11, further comprising establishing a communications connection between the communications device and one of a plurality of agent devices, the one of the plurality of agent devices being determined based on the response (Col. 16, lines 20-34).

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Sidhu et al.** (US 6,744,759) teach registering users for calling services using SIP.

**Gudjonsson et al.** (US6,564,261) teach setting up chat sessions using SIP.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)


Hand-delivered responses should be brought to Carlyle, Alexandria, VA 22313  
(Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (571) 272-7543. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (571) 272-7547.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

  
**Allan Hoosain**  
**Primary Examiner**  
4/4/05